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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/673,333	02/28/2001	Brian Miki	1096.001C	5110

23405 7590 01/27/2003

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ALBANY, NY 12203

EXAMINER

COLLINS, CYNTHIA E

ART UNIT	PAPER NUMBER
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1638

DATE MAILED: 01/27/2003

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Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Applicati n No.

09/673,333

Applicant(s)

MIKI ET AL.

Examiner

Cynthia Collins

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 18 November 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-44 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claim(s) 1-44 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Election/Restrictions

Restriction is required under 35 U.S.C. 121 and 372.

This application contains the following inventions or groups of inventions which are not so linked as to form a single general inventive concept under PCT Rule 13.1.

In accordance with 37 CFR 1.499, applicant is required, in reply to this action, to elect a single invention to which the claims must be restricted.

Group I, claim(s) 1-10, 21 and 29, drawn to an isolated genomic DNA sequence characterized by the restriction map of Figure 11(a) (SEQ ID NO:8).

Group II, claim(s) 1-10, 21 and 29, drawn to an isolated genomic DNA sequence characterized by the restriction map of Figure 11(b) (SEQ ID NO:5).

Group III, claim(s) 1-10, 21 and 29, drawn to an isolated genomic DNA sequence characterized by the restriction map of Figure 11(c) (SEQ ID NO:7).

Group IV, claim(s) 1-10, 21 and 29, drawn to an isolated genomic DNA sequence characterized by the restriction map of Figure 11(d) (SEQ ID NO:9).

Group V, claim(s) 11-20, 22-28, 30-32 and 37-40, drawn to a seed coat promoter obtained from the genomic DNA of SEQ ID NO:7, and to a vector, plant cell and seed comprising said promoter.

Group VI, claim(s) 11-20, 22-28, 30, 33-34, 41 and 43, drawn to a seed coat promoter obtained from the genomic DNA of SEQ ID NO:8, and to a vector, plant cell and seed comprising said promoter.

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Group VII, claim(s) 11-20, 22-28, 30, 35-36, 42 and 44, drawn to a seed coat promoter obtained from the genomic DNA of SEQ ID NO:9, and to a vector, plant cell and seed comprising said promoter.

The inventions listed as Groups I-VII do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, they lack the same or corresponding special technical features for the following reasons:

The technical feature linking the inventions of Groups I-VII appears to be an isolated genomic DNA sequence differentially expressed in seed coat tissues. However, an isolated genomic DNA sequence differentially expressed in seed coat tissues is obvious or anticipated over any of CA 2 186 833, MINI OF AGRICULTURE AND AGRI, 31 March 1998; CA 2 211 018, CANADA MAJESTY IN RIGHT OF, 30 March 1998; WO 97 15656, INDIANA CROP IMPROVEMENT ASS, 1 May 1997; CA 2 149 000, FOBERT et al., 10 November 1996; FOBERT et al., The Plant Journal, Vol. 6, No. 4, 1 January 1994; WO 91 09957, DU PONT, 11 July 1991; COLUMBO et al., The Plant Cell, Vol. 9, No. 5, 1997; see Applicant's Search Report), and therefore does not constitute a special technical feature as defined by PCT Rule 13.2, because it does not define a contribution over the prior art.

The special technical feature of Group I is the isolated genomic DNA sequence characterized by the restriction map of Figure 11(a) (SEQ ID NO:8), which is not a special technical feature of Groups II-VII. The special technical feature of Group II is the isolated genomic DNA sequence characterized by the restriction map of Figure 11(b) (SEQ ID NO:5), which is not a special technical feature of Groups I and II-VII. The special technical feature of

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Group III is the isolated genomic DNA sequence characterized by the restriction map of Figure 11(c) (SEQ ID NO:7), which is not a special technical feature of Groups I-II and IV-VII. The special technical feature of Group IV is the isolated genomic DNA sequence characterized by the restriction map of Figure 11(d) (SEQ ID NO:9), which is not a special technical feature of Groups I-III and V-VII. The special technical feature of Group V is the seed coat promoter obtained from the genomic DNA of SEQ ID NO:7, which is not a special technical feature of Groups I-IV and VI-VII. The special technical feature of Group VI is the seed coat promoter obtained from the genomic DNA of SEQ ID NO:8, which is not a special technical feature of Groups I-V and VII. The special technical feature of Group VII is the seed coat promoter obtained from the genomic DNA of SEQ ID NO:9, which is not a special technical feature of Groups I-VI.

Applicants are reminded that nucleotide sequences encoding different amino acid sequences are structurally distinct chemical compounds and are unrelated to one another. These sequences are thus deemed to normally constitute **independent and distinct** inventions within the meaning of 35 U.S.C. 121. Absent evidence to the contrary, each such nucleotide sequence is presumed to represent an independent and distinct invention, subject to a restriction requirement pursuant to 35 U.S.C. 121 and 37 CFR 1.141 et seq. This requirement is not to be construed as a requirement for an election of species, since each nucleotide and amino acid sequence is not a member of a single genus of invention, but constitutes an independent and patentably distinct invention.

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Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Cynthia Collins whose telephone number is (703) 605-1210. The examiner can normally be reached on Monday-Friday 8:45 AM -5:15 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Amy Nelson can be reached on (703) 306-3218. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 308-4242 for regular communications and (703) 308-4242 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0196.

CC
January 23, 2003

DAVID T. FOX
PRIMARY EXAMINER
GROUP 1638

